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EXAMINER
PATTERSON, MARC A

ART UNIT	PAPER NUMBER
1772	13

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/492,173	ITO ET AL.
	Examiner	Art Unit
	Marc A Patterson	1772

#13

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 November 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *7-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

WITHDRAWN REJECTIONS

1. The 35 U.S.C. 112 second paragraph rejection of Claims 7 – 29, 35 U.S.C. 103(a) rejection of Claims 7 – 10, 13, 15, 18, 20, 23, 25 and 28 as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538), 35 U.S.C. 103(a) rejection of Claims 11 – 12, 16 – 17, 21 – 22 and 26 – 27 as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Amberg et al (U.S. Patent No. 3,760,968) and 35 U.S.C. 103(a) rejection of Claims 14, 19, 24 and 29 as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Yoshinaka et al (U.S. Patent No. 4,996,291), of record on page 2 of the previous Action, are withdrawn.

NEW REJECTIONS

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7 – 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase 'the polyester elastomer' is indefinite as its meaning is unclear. For purposes of examination, the phrase will be assumed to mean 'a polyester elastomer.' The phrase 99.9 wt% of a polyester' is also indefinite as it is unclear what the difference is between 'polyester' and 'polyester elastomer.' For purposes of examination, the phrase will be assumed to mean a non – elastomeric polyester such as a thermoplastic polyester resin. The phrases 'when the film is put in hot water of 70 degrees Celsius for 5 sec' and 'when the film is put in hot water

of 95 degrees Celsius for 5 sec' and 'when the film is put in hot water of 80 degrees Celsius for 5 sec' are indefinite as it is unclear whether the film is put in hot water or not (the phrase 'when the film is put' is the same as 'if the film is put in hot water'); the phrase also recites a process limitation, and will therefore be given little patentable weight. For purposes of examination the phrase will be assumed to be directed to a shrinkable film having any shrinkage. The phrase 'when the film is formed into a label' is indefinite as it is unclear whether a film or label is being claimed. The term 'formed' is also a method limitation, and thus will be given little patentable weight. For purposes of examination, it will be assumed that the phrase 'a heat shrinkable polyester film' means 'a heat shrinkable polyester film for a label.' The abbreviation 'wt' is indefinite as it has not been defined. For purposes of examination, the abbreviation will be assumed to mean 'weight.'

3. Claim 7 recites the limitation "adhesive retention" in line 12. There is insufficient antecedent basis for this limitation in the claim.

4. Claims 8 – 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 8 – 10 recite the limitation "adhesive retention" in line 2. There is insufficient antecedent basis for this limitation in the claim.

5. Claims 20 – 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase 'a preform process' is indefinite as its meaning is unclear. For purposes of examination, the phrase will be assumed to mean any process. Claim 20 recites the limitation "preform" in line 11. There is insufficient antecedent basis for this limitation in the claim.

6. Claims 25 – 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase 'preform finish defect percentage' is indefinite, as its meaning is unclear. For purposes of examination, the phrase will be assumed to refer to any property. Claim 25 recites the limitation "preform" in line10. There is insufficient antecedent basis for this limitation in the claim. Correction and / or clarification is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 7 – 10, 13, 15, 18, 20, 23, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Shibuya et al (U.S. Patent No. 5,270,390).

With regard to Claims 7 – 10, 13, 18, 20, 23, 25 and 28, Fukuda et al disclose a heat shrinkable polyester film (column 6, lines 37 – 49) for making a label having a bonded portion (the film is used as a label of bottles; column 1, lines 10 – 19). Fukuda et al fail to disclose a film comprising 50 weight percent to 99.9 weight percent thermoplastic polyester resin and 0.1 weight percent to 50 weight percent polyester resin.

Shibuya et al teach a composition comprising 50 weight percent to 99.9 weight percent thermoplastic polyester resin and 0.1 weight percent to 50 weight percent polyester resin in a heat shrinkable polyester film (column 3, lines 29 – 41) for the purpose of making a heat shrinkable film having superior gas barrier property and cold resistance (column 3, lines 25 – 28).

One of ordinary skill in the art would therefore have recognized the advantages of providing for a composition comprising 50 weight percent to 99.9 weight percent thermoplastic polyester resin and 0.1 weight percent to 50 weight percent polyester resin in Fukuda et al, which is also a heat shrinkable polyester film.

It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for a composition comprising 50 weight percent to 99.9 weight percent thermoplastic polyester resin and 0.1 weight percent to 50 weight percent polyester resin in Fukuda et al in order to make a heat shrinkable film having superior gas barrier property and cold resistance as taught by Shibuya et al.

With regard to the claimed aspect of the film being a 'cap sealing label,' the film is used as a label for bottles as discussed above. The claimed aspect of the film being a 'cap sealing label' therefore reads on Fukuda et al.

With regard to Claim 15, the film haze is 10% (column 5, lines 13 – 24) and the thickness is 50 μm (column 15, lines 60 – 61).

8. Claims 11 – 12, 16 – 17, 21 – 22 and 26 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Shibuya et al (U.S. Patent No. 5,270,390) and further in view of Amberg et al (U.S. Patent No. 3,760,968).

Fukuda et al disclose a heat shrinkable polyester film for making a label having a bonded portion as discussed above. With regard to Claims 11 – 12, 16 – 17, 21 – 22 and 26 – 27, Fukuda et al fail to disclose a label which is formed by bonding together two opposite edges of a rectangular sheet of the film.

Amberg et al teach a label which is formed by bonding together two opposite edges of a rectangular sheet of the film (a rectangular sheet of heat shrinkable plastic material has its opposing ends overlapped and seamed; column 3, lines 54 – 67) for the purpose of conforming the label to a tight shape (column 4, lines 2 – 9).

It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for disclose a label which is formed by bonding together two opposite edges of a rectangular sheet of the film in Fukuda et al in order to conform the label to a tight shape as taught by Amberg et al.

9. Claims 14, 19, 24 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Shibuya et al (U.S. Patent No. 5,270,390) and further in view of Yoshinaka et al (U.S. Patent No. 4,996,291).

Fukuda et al disclose a heat shrinkable polyester film for making a label having a bonded portion as discussed above. With regard to Claims 14, 19, 24 and 29, Fukuda et al fail to disclose a label which is a cap – sealing label.

Yoshinaka et al teach that labeling and cap sealing are equivalent as articles comprising a heat shrinkable polyester film (column 1, lines 15 – 32) for the purpose of making an article which attaches closely as a wrapping (column 1, lines 17 – 32).

It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for a label which is a cap – sealing label in Fukuda et al in order to make an article which attaches closely as a wrapping as taught by Yoshinaka et al.

ANSWERS TO APPLICANT'S ARGUMENTS

10. Applicant's arguments regarding the 35 U.S.C. 103(a) rejection of Claims 7 – 10, 13, 15, 18, 20, 23, 25 and 28 as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538), 35 U.S.C. 103(a) rejection of Claims 11 – 12, 16 – 17, 21 – 22 and 26 – 27 as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Amberg et al (U.S. Patent No. 3,760,968) and 35 U.S.C. 103(a) rejection of Claims 14, 19, 24 and 29 as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Yoshinaka et al (U.S. Patent No. 4,996,291), of record on page 2 of the previous Action, have been considered and have been

found to be persuasive. The rejections are therefore withdrawn. The new 35 U.S.C. 112 second paragraph rejections of Claims 7 – 29, 35 U.S.C. 103(a) rejection of Claims 7 – 10, 13, 15, 18, 20, 23, 25 and 28 as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Shibuya et al (U.S. Patent No. 5,270,390), 35 U.S.C. 103(a) rejection of Claims 11 – 12, 16 – 17, 21 – 22 and 26 – 27 as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Shibuya et al (U.S. Patent No. 5,270,390) and further in view of Amberg et al (U.S. Patent No. 3,760,968) and 35 U.S.C. 103(a) rejection of Claims 14, 19, 24 and 29 as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Shibuya et al (U.S. Patent No. 5,270,390) and further in view of Yoshinaka et al (U.S. Patent No. 4,996,291) above are directed to amended Claims 7 – 29.

Applicant's arguments regarding the 35 U.S.C. 112 second paragraph rejection of Claims 7 – 29, of record on page 2 of the previous Action, have been carefully considered but have not been found to be persuasive for the reasons set forth below.

Applicant argues, on page 4 of Paper No. 13, that the phrase 'when the film is put in hot water' is not indefinite, and is not a process limitation; the behavior in water, Applicant argues, is innate to the film, as a boiling point is to water, therefore the film need not be in water to have the property. However, the term 'put' in the phrase is clearly a verb, thus the phrase is a process limitation. Furthermore, it is unclear why patentable weight should be given to the limitation regarding behavior in water, if the film need not be in water to have the property.

Applicant also argues, on page 4, that the phrase 'when the film is formed into a label' is not indefinite, and is not a process limitation; the properties of the film as a label, Applicant argues, are innate to the film, as a boiling point is to water. However, as stated on page 2 of the

previous Action, the phrase makes it unclear whether a film or label of film is claimed. Furthermore, the phrase is clearly a process limitation, as the verb 'formed' is contained in the phrase.

Applicant also argues, on page 5, that the phrase 'adhesive retention' is discussed in the specification, and therefore has sufficient antecedent basis. However, there is no antecedent basis for the term 'adhesive' (presumably the term refers to the dioxolane composition discussed on page 31 of the specification).

Applicant also argues, on page 5, that the phrase 'preform process' is discussed in the specification and is therefore not indefinite. However, as many processes exist in the art which involve performs, the phrase is indefinite unless the full process is claimed. Furthermore, as discussed on page 2 of the previous Action, even if the full process is claimed, processes are given little patentable weight in the absence of unexpected results.

Applicant also argues, on page 5, that the phrase 'preform finish defect percentage' is discussed in the specification and is therefore not indefinite. However, as discussed in the specification, the phrase is dependent on a process, and the process is not claimed. Furthermore, as discussed above, processes are given little patentable weight.

The 35 U.S.C. 112 second paragraph rejections with regard to the terms 'sec' and 'hot' and the phrase 'cap sealing heat shrinkable polyester film' are withdrawn, as the terms and phrase have been withdrawn from the claims.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (703) 305-3537. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (703) 308-4251. FAX communications should be sent to (703) 872-9310. FAXs received after 4 P.M. will not be processed until the following business day.

Marc A. Patterson, PhD.
Marc Patterson
Art Unit 1772

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

1/23/03